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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,338	03/01/2002	John p. Ruckart	010417	4121
36192	7590	07/27/2005	EXAMINER	
CANTOR COLBURN LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,338	RUCKART, JOHN P.	
	Examiner	Art Unit	
	Lisa Hashem	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S.

Patent Application Publication Number US 2002/0077157 by Okun et al, hereinafter Okun.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (e.g. a subscriber profile indicates determining whether a text or voice message is preferred for a calling party in order to send a message to a calling party that is on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12); a services node or serving MSC (Figure 1A, 118) for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service; placing the incoming call on hold prior to the call being answered; playing a message to the calling party (section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to the

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calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure 1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-13 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0137493 by Dutta in view of Okun.

Regarding claim 6, Dutta discloses a method of placing an incoming call to a telecommunications device from a calling party on hold prior to being answered by a called party (Fig. 6), the method comprising: receiving one or more parameters of a hold function wherein the parameters include at least one of a schedule including at least one time period during which the incoming call is placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold (section 0036, lines 1-24); automatically answering the call if the call corresponds to the one or more parameters of the hold function; and connecting the called party to the calling party when the called party answers the call (section 0040, lines 1-9).

Dutta does not disclose playing a message to the calling party.

Okun discloses a method of placing an incoming call to a telecommunications device from a calling party on hold prior to being answered by a called party (section 0040, lines 1-11), the method comprising: receiving one or more parameters of a hold function wherein the parameters include playing a message to the calling party in an appropriate or preferred format (e.g. text or voice) (section 0044, lines 1-24); automatically answering the call; playing a

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message to the calling party; and connecting the called party to the calling party when the called party answers the call (section 0062, lines 1-10).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Dutta to include playing a message to the calling party as taught by Okun. One of ordinary skill in the art would have been lead to make such a modification to include playing a message to a calling party to provide information to the calling party about the called party's intentions.

Regarding claim 7, the method of claim 6, wherein Dutta further discloses determining whether the called party has enabled a hold function (section 0036, lines 1-7; section 0037, lines 1-15).

Regarding claim 8, the method of claim 6, wherein Okun further discloses determining whether the called party has pressed a button on the telecommunications device to enable a hold function (section 0015, lines 1-10).

Regarding claim 9, the method of claim 6, wherein Dutta further discloses alerting the called party of the incoming call (section 0040, lines 5-8).

Regarding claim 10, the method of claim 6, wherein Okun further discloses connecting the calling party to a voicemail system when the called party does not answer the call within a predetermined time period (section 0021, lines 1-21).

Regarding claim 11, the method of claim 6, wherein Okun further discloses playing a message to the calling party includes playing a message that is resident on a services node (Fig. 1A: 118, 120) of a telecommunications network (section 0057, lines 1-13).

Regarding claim 12, the method of claim 6, wherein Okun further discloses playing a message to the calling party includes playing a pre-recorded message stored in a memory device resident on the telecommunications device (section 0016, lines 1-8).

Regarding claim 13, the method of claim 6, wherein Dutta further discloses connecting the call to a voicemail system when the called party presses a button on the telecommunications device (section 0040, lines 8-10).

Regarding claim 21, the method of claim 6, wherein Dutta further discloses the receiving one or more parameters of the hold function is performed via a web interface (section 0004, lines 1-9; Fig. 5; section 0041, line 1 - section 0044, line 10).

Regarding claim 17, Dutta discloses an apparatus or Bluetooth server, comprising: means for receiving one or more parameters of a hold function, wherein said parameters include at least a schedule including at least one time period during which the incoming call is placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold (Fig. 6; section 0036, lines 1-24); means for automatically answering a call placed by a calling party to a called party, if the call corresponds to the one or more parameters; and means for connecting the called party to the calling party when the called party answers the call (section 0040, lines 1-9).

Dutta does not disclose means for playing a message to the calling party.

Okun discloses an apparatus or serving MSC (Figure 1A, 118), comprising: means for receiving one or more parameters of a hold function, wherein said parameters include playing a message to the calling party in an appropriate or preferred format (e.g. text or voice) (section 0044, lines 1-24); means for automatically answering a call placed by a calling party to a called

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party; means for playing a message to the calling party; and means for connecting the called party to the calling party when the called party answers the call (section 0057, lines 1-13; section 0062, lines 1-10).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the apparatus of Dutta to include playing a message to the calling party as taught by Okun. One of ordinary skill in the art would have been lead to make such a modification to include playing a message to a calling party to provide information to the calling party about the called party's intentions.

Regarding claim 18, the apparatus of claim 17, wherein Okun further discloses means for determining whether the called party has enabled a hold function (section 0057, lines 1-13).

Regarding claim 19, the apparatus of claim 17, wherein Okun further discloses means for determining whether the called party has pressed a button on the telecommunications device to enable a hold function (section 0057, lines 1-13).

Regarding claim 20, the apparatus of claim 17, wherein Okun further discloses means for alerting the called party of the incoming call (section 0057, lines 1-4).

Regarding claim 22, the apparatus of claim 17, wherein Dutta further discloses the means for receiving one or more parameters of the hold function receives the one or more parameters via a web interface (section 0004, lines 1-9; Fig. 5; section 0041, line 1 - section 0044, line 10).

Response to Arguments

5. All 35 U.S.C. 112, 1st and 2nd paragraph rejections not mentioned below filed in the office action dated 2-9-2005 are withdrawn.

6. In regards to Applicant's arguments, see Amendment, filed 5-9-2005, that Okun does not teach the features of claim 14, claim 14 '...determines whether to place a call on hold based on a user profile...', and '...In Okun, the user presses keys to either answer a call or place a caller on hold...'. Examiner agrees that Okun discloses the user presses keys to either answer a call or place a caller on hold. However, claim 14 recites '...a services node for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming hold service...'. There is no mention of determining whether to place a call on hold based on a user profile in the claim limitations. Further claim 14 recites '...the user profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system...'. Okun clearly discloses such indication by including in a subscriber profile, an appropriate format (e.g. text or voice) in which to send a message to a calling party that is on hold based on a preferred method of a calling party.

In conclusion Okun clearly discloses the claimed invention. Please see all rejections above.

7. Applicant's arguments with respect to claims 14-16 have been fully considered but they are not persuasive.

8. Applicant's arguments with respect to claims 6-13 and 17-22 have been considered but are moot in view of the new ground(s) of rejection.

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9. Accordingly, this action is **FINAL**.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,782,252 by Kang et al disclose a call holding voice message transmitting apparatus and method in a mobile communication terminal that transmit voice data, preferably stored in the terminal, to a caller in a situation in which the user of the terminal cannot receive an incoming call from the caller

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

July 15, 2005



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